

## **REMARKS**

The Office Action mailed November 25, 2008 reopened prosecution of this application in view of the results of Applicant's Pre-Appeal Brief Conference Request. In the Office Action,<sup>1</sup> the Examiner objected to the Abstract of the disclosure; objected to claims 1-34 for various minor informalities; rejected claims 1-34 under 35 U.S.C. § 101 as directed to non-statutory subject matter; rejected claims 1-34 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim subject matter; rejected claims 1, 10-17, and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,770,033 to Fink et al. ("*Fink*"); rejected claims 2-9 under 35 U.S.C. § 103(a) as being unpatentable over *Fink* in view of U.S. Patent No. 5,545,124 to Krause et al. ("*Krause*"); rejected claims 18-23 under 35 U.S.C. § 103(a) as being unpatentable over *Fink* in view of U.S. Patent Publication No. 2004/0064050 to Liu et al. ("*Liu*"); rejected claims 25-31 under 35 U.S.C. § 103(a) as being unpatentable over *Fink* in view of *Liu*; and rejected claims 32-34 under 35 U.S.C. § 103(a) as being unpatentable over *Fink* in view of *Liu* and U.S. Patent No 5,115,808 to Popovic et al. ("*Popovic*").

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<sup>1</sup> The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any such statement. Further, silence with regard to rejection of a dependent claim, when such claim depends, directly or indirectly, from an independent claim which Applicant deems allowable for reasons provided herein, is not acquiescence to such rejection of that dependent claim, but is recognition by Applicant that such previously lodged rejection is moot based on remarks and/or amendments presented herein relative to that independent claim.

By this Amendment, Applicant has amended claims 1, 3, 4, 6-26, 29, 30, and 32-34, cancelled claims 2 and 10, and added new claim 35. No new matter has been added.

Regarding the objection to the Abstract, the Examiner is respectfully directed to the Amendment filed July 24, 2007, in which Applicant amended the Abstract, according to the Examiner's suggestions, to read as follows:

The present invention relates to an analysis apparatus for analyzing the skin, which includes an ultrasound probe arranged to analyze the skin along an axis and a vibrator arranged to emit at least one shear wave to a region of the skin extending about the axis. The ultrasound probe is arranged to detect displacements induced in the skin by the propagation of the shear wave.

Regarding the objections to claims 1-34 for various alleged minor informalities,<sup>2</sup> Applicant has amended claims 1, 3, 4, 6-26, 29, 30, and 32-34, and believes such amendments render the objections moot. Therefore, Applicant respectfully requests withdrawal of the objections to claims 1-34.

Applicant respectfully traverses the rejection of claims 1-34 under 35 U.S.C. § 101 as allegedly drawn to non-statutory subject matter. By this Amendment, Applicant has amended claims 1, 3, 4, 6-26, 29, 30, and 32-34, and believes such amendments render the rejections under 35 U.S.C. § 101 moot. Therefore, Applicant respectfully requests withdrawal of the Section 101 rejections of claims 1-34.

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<sup>2</sup> Applicant respectfully notes that while the Examiner has indicated an objection to all of claims 1-34, the Examiner has only explicitly addressed alleged informalities present in claims 1, 3, 16, 17, 20, 24, 26, and 32. To the extent the Examiner has implicitly objected to claims 2, 4-15, 18, 19, 21-23, 25, 27-31, and 33-34, Applicant believes that the Amendments herein address any and all objections to which the Examiner referred in the Office Action.

Applicant respectfully traverses the rejection of claims 1-34 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.<sup>3</sup> Without subscribing to the propriety of the rejection under Section 112, second paragraph, and with the goal of furthering prosecution, Applicant has amended claims 1, 3, 4, 6-26, 29, 30, and 32-34, and respectfully submits that the amendments therein render the rejections under 35 U.S.C. § 112, second paragraph moot. Therefore, Applicant respectfully requests the timely withdrawal of the Section 112 rejections.

Applicant respectfully traverses the rejection of claims 1, 10-17, and 24 as being anticipated under 35 U.S.C. § 102(b) by *Fink* for at least the reason that *Fink* does not teach or suggest each and every recitation of amended independent claim 1. To anticipate a claim, a reference must teach every element of the claim. M.P.E.P. § 2131 (8<sup>th</sup> ed. 2001, revised August 2007). For example, amended independent claim 1 recites, among others, “a coupling member configured to contact a region of skin ... an ultrasound probe having a probe surface ... a vibrator ... configured to emit at least one shear wave to the region of skin via the contact surface in contact with the coupling member ... wherein the ultrasound probe extends through the central bore such that the probe surface contacts the coupling member.” *Fink* does not teach at least a coupling member configured to contact a region of skin ... an ultrasound probe having a probe surface ... a vibrator ... configured to emit at

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<sup>3</sup> Applicant respectfully notes that while the Examiner appears to have rejected all of claims 1-34 under Section 112, second paragraph, the Examiner has only explicitly addressed rejections of claims 1, 13-15, 22, 25, and 32-34. To the extent the Examiner has implicitly rejected claims 2-12, 16-21, and 26-31 under Section 112, second paragraph, Applicant respectfully submit that the amendments herein render any and all such implicit rejections moot.

least one shear wave to the region of skin via the contact surface in contact with the coupling member ... and wherein the ultrasound probe extends through the central bore such that the probe surface contacts the coupling member. Therefore, the Section 102 rejection of independent claim 1 and pending claims 10-17 and 24, should be withdrawn and the claims allowed.

Applicant respectfully traverses the rejection of claims 2-9 under 35 U.S.C. § 103(a) as being unpatentable over *Fink* in view of *Krause*. As indicated above, Applicant has cancelled claim 2. Applicant has also incorporated features of claim 2 into claim 1. Even if a person of ordinary skill would have been motivated to combine the acoustic coupler of *Krause* with the embodiment of *Fink* Fig. 2, which Applicant does not concede, the combination would not teach all features of claim 1. In particular, the part of the *Fink* “probe 6” that the Office appears to treat as the claimed probe surface and the part of the *Fink* “loudspeaker or vibrator 2” that the Office appears to treat as the claimed contact surface lie in different planes that are separated by a significant distance. If a *Krause* acoustic coupler was interposed between the probe surface of probe 6 and a patient’s skin, no surface of speaker 2 would be in contact with that acoustic coupler.

Further, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 3-9 for at least the reason that none of *Fink*, *Krause*, *Liu*, and/or *Popovic* taken alone or in any reasonable combination teach or suggest each and every claim element of claims 3-9. As detailed above, neither *Fink* nor a *Fink/Krause* combination teaches or suggests each and every element of at least amended independent claim 1, from which claims 3-9 depend.

Further, neither can the addition of *Liu* and/or *Popovic* remedy these deficiencies, nor has the Examiner so alleged. Therefore, Applicant respectfully submits that the rejection of claims 3-9 under Section 103(a) should be withdrawn and the claims allowed.

Applicant respectfully traverses the rejection of claims 18-23 under 35 U.S.C. § 103(a) as being unpatentable over *Fink* in view of *Liu*. Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 18-23 for at least the reason that none of *Fink*, *Krause*, *Liu*, and/or *Popovic*, taken alone or in any reasonable combination teach or suggest each and every claim element of claims 18-23. As detailed above, neither *Fink* nor a *Fink/Krause* combination teaches or suggests each and every element of at least amended independent claim 1, from which claims 18-23 depend. The addition of *Liu* for its alleged teaching of skin analysis and data acquisition over time does not remedy the deficiencies described above. Further, the addition of *Popovic* cannot remedy these deficiencies, and the Examiner has not so alleged. Therefore, Applicant respectfully submits that the rejection of claims 18-23 under Section 103(a) should be withdrawn and the claims allowed.

Applicant respectfully traverses the rejection of claims 25-31 under 35 U.S.C. § 103(a) as being unpatentable over *Fink* in view of *Liu*. Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 25-31 for at least the reason that none of *Fink*, *Krause*, *Liu*, and/or *Popovic*, taken alone or in any reasonable combination teach or suggest each and every claim element of claims 25-31. *Fink* does not teach or suggest each and every element of

at least amended independent claim 25. Amended independent claim 25 recites, among other features, applying an apparatus to a region of skin associated with a patient, and further recites features of the applied apparatus similar to those recited in claim 1. As set forth above in connection with claim 1, neither *Fink* nor a *Fink/Krause* combination teaches such features, and addition of *Liu* for its alleged teaching of skin analysis and data acquisition over time does not remedy the deficiencies described above. Therefore, Applicant respectfully submits that the rejection of amended independent claim 25, and claims depending therefrom (i.e., 26-30) under Section 103(a) should be withdrawn and the claims allowed. Moreover, for reasons discussed above with regard to dependent claims 18-23, the rejection of dependent claim 31 should be withdrawn and the claim allowed.

Applicant respectfully traverses the rejection of claims 32-34 under 35 U.S.C. § 103(a) as being unpatentable over *Fink* in view of *Liu* and U.S. Patent No 5,115,808 to Popovic et al ("*Popovic*"). Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 32-34 for at least the reason that none of *Fink*, *Krause*, *Liu*, and/or *Popovic*, taken alone or in any reasonable combination teach or suggest each and every claim element of claims 32-34. As detailed above, neither *Fink* nor a *Fink/Krause* combination teaches or suggests each and every element of at least amended independent claim 1, from which claims 32-34 depend. The addition of *Liu* for its alleged teaching of skin analysis and data acquisition over time and *Popovic* for its alleged teaching of measurement of skin elasticity, does not remedy the deficiencies described above.

Therefore, Applicant respectfully submits that the rejection of claims 18-23 under Section 103(a) should be withdrawn and the claims allowed.

Applicant respectfully submits that new independent claim 35 is allowable for at least the reason that none of the prior art cited in the Office Action, taken alone or in any reasonable combination, teaches or suggests every element of new independent claim 35.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and timely allowance of the pending claims. If the Examiner believes that a telephone call would be helpful for furthering prosecution, the Examiner is invited to call the Applicant's representative at the phone number below.

Respectfully submitted,

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